

ESTTA Tracking number: **ESTTA590635**

Filing date: **03/04/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Gregg Charalambous		
Entity	Individual	Citizenship	UNITED STATES
Address	3217 Barton View Drive Austin, TX 78735 UNITED STATES		

Attorney information	Joshua M. Gerben, Esq. Gerben Law Firm, PLLC 1050 Connecticut Ave NW Washington, DC 20036 UNITED STATES jgerben@gerbenlawfirm.com Phone:202-294-2287
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Applicant Information

Application No	86025797	Publication date	02/11/2014
Opposition Filing Date	03/04/2014	Opposition Period Ends	03/13/2014
Applicant	Tighe, Austin 17105 Yellowstar Dr Austin, TX 78738 USX		

Goods/Services Affected by Opposition


Class 025. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: Clothing, namely, hats and t-shirts

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	86180422	Application Date	01/30/2014
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	IT'S AUSTIN NOT TEXAS		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 2008/00/00 First Use In Commerce: 2008/00/00 Shirts; T-shirts

Attachments	86180422#TMSN.jpeg(bytes) ITS NOT TEXAS ITS AUSTIN_Opposition_03032014.pdf(124996 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Joshua M. Gerben/
Name	Joshua M. Gerben, Esq.
Date	03/04/2014

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

GREGG CHARALAMBOUS

Opposer,

v.

AUSTIN TIGHE

Applicant.

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Opposition No. _____

Mark: IT'S NOT TEXAS. IT'S AUSTIN

Serial No. 86025797

Notice of Opposition

Opposer, GREGG CHARALAMBOUS (hereinafter referred to as "Opposer"), a United States Citizen with an address of 3217 Barton View Drive, Austin, Texas, believes that that he will be damaged by the registration of the mark shown in Application Serial No. 86025797 and hereby opposes this application. This application was filed by AUSTIN TIGHE, a United States Citizen having an address of 17105 Yellowstar Drive, Austin, Texas (hereinafter referred to as "Applicant") and was published in the Official Gazette on February 11, 2014.

As grounds for the opposition, Opposer alleges as follows:

1. Opposer filed a trademark application on January 30, 2014 for ITS'S AUSTIN NOT TEXAS for "Shirts; T-shirts" in International Class 25 (the "Opposer's Goods") and was assigned Serial Number 86180422 (the "Opposer's Application").
2. Applicant filed an intent-to-use trademark application on August 1, 2013 for IT'S NOT TEXAS. IT'S AUSTIN. for "Clothing, namely, hats and t-shirts" in International Class 25 (the "Applicant's Goods") and was assigned Serial Number 86025797 (the "Applicant's Application").

3. Opposer has offered the Opposer's Goods in the United States under the IT'S AUSTIN NOT TEXAS mark since at least as early as 2008.

4. Opposer has openly and continuously used the IT'S AUSTIN NOT TEXAS mark since at least as early as 2008.

5. Opposer has promoted the Opposer's Goods under the IT'S AUSTIN NOT TEXAS mark since at least as early as 2008 and has built up substantial goodwill in the mark.

6. Applicant's Application is for a mark nearly identical to Opposer's mark.

7. Applicant's Application is for goods that are very similar to Opposer's Goods.

8. Applicant's Application is based upon an intent to use the trademark in commerce.

9. Opposer has offered the Opposer's Goods in the United States under the IT'S AUSTIN NOT TEXAS mark since at least as early as 2008, a date prior to filing date of the Applicant's Application.

10. The Opposer's use has been valid and continuous since its date of first use and has not been abandoned. Opposer's mark is symbolic of extensive goodwill and consumer recognition built up by Opposer through substantial amounts of time and effort in promotion of Opposer's products.

11. Therefore, the Opposer has priority on the IT'S AUSTIN NOT TEXAS mark based upon its open and continuous use of the IT'S AUSTIN NOT TEXAS mark prior to the date the Applicant's Application was filed with the United States Patent and Trademark Office based on an intent to use in commerce.

12. In view of the fact that the parties' respective marks and goods are virtually identical, it is alleged that Applicant's mark so resembles Opposer's mark previously used in the

United States, and not abandoned, as to be likely to cause confusion, or to cause mistake, or to deceive.

13. If Applicant is granted the registration herein opposed, it would thereby obtain at least a prima facie exclusive right to the use of its mark. Such registration would be a source of damage and injury to Opposer, and would likely stand in the way of Opposer's good faith attempt to register its mark IT'S AUSTIN NOT TEXAS.

14. In view of the above, Applicant is not entitled to federal registration of its alleged mark "IT'S NOT TEXAS. IT'S AUSTIN." as Opposer has priority based on use of the virtually identical "IT'S AUSTIN NOT TEXAS" mark in commerce in connection with goods highly related, complementary and/or overlapping to Applicant's Goods.

15. By reason of all the foregoing, Opposer will be gravely damaged by the registration of Applicant's mark.

WHEREFORE, by its undersigned attorney, GREGG CHARALAMBOUS, respectfully requests that this Notice of Opposition be sustained and that registration of the mark "IT'S NOT TEXAS. IT'S AUSTIN.", Serial No. 86025797, be refused.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "J. Gerben", with a stylized flourish at the end.

Dated: March 4, 2014

Joshua M. Gerben, Esq.
Attorney for Opposer
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1050 Connecticut Ave NW
10th Floor
Washington, DC 20036
Phone: 202.294.2287
Fax: 202.315.3386
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CERTIFICATE OF SERVICE

I hereby certify that on March 4 2014, a true and correct copy of the foregoing Notice of Opposition is being served by certified mail, return receipt requested on Applicant as shown in the correspondence record in the Office, as follows:

Austin Tighe
17105 Yellowstar Drive
Austin, TX 78738

Dated: March 4, 2014

A handwritten signature in black ink, appearing to read 'J. Gerben', with a stylized, flowing script.

Joshua M. Gerben, Esq.
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